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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,894	08/29/2001	Eric D. Anderson	500247.02	2382

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EXAMINER

ENGLAND, DAVID E

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/943,894	ANDERSON, ERIC D.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David E. England	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-22, 37, 39-41, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-22, 37, 39-41, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. Claims 11 – 22, 37, 39 – 41, 43 and 44 are presented for examination.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11, 17, 18, 20, 22, 37 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin et al. (5941946) (hereinafter Baldwin) in view of Aronson et al. (6654787) (hereinafter Aronson).

4. As per claim 11, as closely interpreted by the Examiner, Baldwin teaches a computer-implemented method for sending an Email communication to recipients, the method comprising:

5. providing an Email communication program on a server that performs the acts of:

6. receiving an Email communication, including an indication of at least one recipient to receive the Email communication, (e.g., col. 3, lines 25 – 40);

7. determining by the Email communication program, whether multiple recipients of the Email communication have been indicated in the received indication, (e.g., col. 3, lines 25 – 40);

and

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8. if it is determined that multiple recipients have been indicated,
9. notifying each of the multiple recipients of the Email communication without sending the Email communication to the recipients, (e.g., col. 3, lines 25 – 63); and
10. in response to a request for the Email communication from a recipient, sending the Email communication to the recipient, (e.g., col. 5, lines 49 – 56);
11. determined that multiple recipients have not been indicated, (e.g., col. 3, lines 25 – 63 & col. 5, lines 49 – 56).
12. Baldwin does not specifically teach storing a single copy of the Email communication on the server;
13. if it is determined that multiple recipients have not been indicated,
14. sending the Email communication to the recipient without waiting for a request for the Email communication.
15. Aronson teaches receiving an Email communication, including an indication of at least one recipient to receive the Email communication, (e.g. col. 5, lines 20 – 67 & col. 10, line 65 – col. 11, line 5);
16. storing a single copy of the Email communication on the, (e.g. col. 5, lines 20 – 67 & col. 10, line 65 – col. 11, line 5);
17. if it is determined that multiple recipients have not been indicated,
18. sending the Email communication to the recipient without waiting for a request for the Email communication, (e.g., col. 8, lines 17 – 64).

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19. It would have been obvious to one skilled in the art at the time the invention was made to combine Aronson with Baldwin because storing only one copy of a message in a server or directly sending the message to a user conserves significant memory space.

20. As per claim 17, as closely interpreted by the Examiner, Baldwin teaches wherein the notifying of a recipient of the Email communication involves sending a distinct indicator Email communication to the recipient by the Email communication program, (e.g. col. 5, lines 16 – 48).

As per claim 18, as closely interpreted by the Examiner, Baldwin teaches including retrieving notifying instructions for a recipient by the Email communication program, and wherein the notifying of the recipient is performed according to the notifying instructions, (e.g. col. 5, lines 16 – 48).

21. As per claim 20, as closely interpreted by the Examiner, Baldwin teaches wherein the notifying instructions are supplied by the recipient, (e.g. col. 5, lines 16 – 48).

22. As per claim 22, as closely interpreted by the Examiner, Baldwin teaches wherein the notifying instructions indicate that the notifying is to be performed in an encrypted manner, (e.g. col. 9, line 60 – col. 10, line 14).

23. Claims 37 and 41 are rejected for similar reasons as stated above.

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24. Claims 13, 16, 19, 21, 39 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin and Aronson in further view of Arnold (6275848).

25. As per claim 13, as closely interpreted by the Examiner, Baldwin teaches the use of storing and sending Email communication but does not specifically teach tracking the sending of the Email communication to the recipients; and

26. when the Email communication has been sent to all of the recipients, deleting the stored Email communication by the Email communication program. Arnold teaches tracking the sending of a communication to the recipients, (e.g. col. 4, line 25 – col. 5, line 25); and

27. when a communication has been sent to all of the recipients, deleting the stored Email communication by the Email communication program, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold's limitation of deleting an attachment after all recipients have viewed it with Baldwin's limitation of storing Email because it is common for systems to utilize a Email server to store Email for recipients and if a group of recipients have all viewed the Email and no longer desire the use of the stored Email on the Email server then it would be advantageous for the Email to be deleted so the Email server can have more space for other Emails that are to be sent.

28. As per claim 16, as closely interpreted by the Examiner, Baldwin and Aronson do not specifically teach determining a period of time for which the Email communication will be stored; and

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29. when the determined period of time has expired, deleting the stored Email communication by the Email communication program. Arnold teaches determining a period of time for which the Email communication will be stored, (e.g. col. 4, line 25 – col. 5, line 25); and

30. when the determined period of time has expired, deleting the stored Email communication by the Email communication program, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with the combine system of Baldwin and Aronson because of reasons disclosed above, furthermore, if a user has information that is forgotten for a period of time, the system could delete this information, therefore freeing up space in memory.

31. As per claim 19, as closely interpreted by the Examiner, Baldwin and Aronson do not specifically teach wherein the notifying instructions are supplied by a sender of the Email communication. Arnold teaches wherein the notifying instructions are supplied by a sender of the Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Baldwin because if the sender needed specific functions to be carried out with the Email communication it would be more efficient for a system to have the sender send instructions to a Email server to only allow specific recipients in a group to access the Email communication, delete the Email at a specific time, automatically send the Email to recipients at a specified time, etc.

32. As per claim 21, as closely interpreted by the Examiner, Baldwin and Aronson do not specifically teach wherein the notifying instructions are determined automatically by the Email

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communication program based on past interactions with the recipient. Arnold teaches wherein the notifying instructions are determined automatically by the Email communication program based on past interactions with the recipient, (e.g. col. 5, line 25 – col. 6, line 49). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Baldwin because it is a more efficient way to have a Email communication dealt with, therefore saving time on the users side.

33. Claims 39 and 43 are rejected for similar reasons as stated above.

34. Claims 14, 15, 40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin, Aronson and Arnold in further view of Foladare et al. (6311210) (hereinafter Foladare).

35. As per claim 14, as closely interpreted by the Examiner, Baldwin and Aronson do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that none of the recipients have indicated that the Email communication is to be saved, deleting the stored Email communication by the Email communication program. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients and that none of the recipients have indicated that the Email communication is to be saved, deleting the stored Email communication by the Email communication program, (e.g. col. 3, lines 15 – 35). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Baldwin, Aronson and Arnold because



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if the Email communication is no longer needed, the user could have it deleted, therefore freeing up space on the system.

36. As per claim 15, as closely interpreted by the Examiner, Baldwin, Aronson and Arnold do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication by the Email communication program. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication by the Email communication program, (e.g. col. 3, line 55 – col. 4, line 15). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Baldwin, Aronson and Arnold because in case a user makes the mistake of deleting information or is unsure if the information selected for deletion is correct, the system would have to have permission to delete the information. This could be used in a form of error checking.

37. Claims 40 and 44 are rejected for similar reasons as stated above.

### ***Response to Arguments***

38. Applicant's arguments filed 04/19/2006 have been fully considered but they are not persuasive.

39. In the Remarks, Applicant argues in substance that Baldwin teaches that “if there are multiple recipients, the sender’s station deposits the message to the message stores associated with each of the recipient.” Thus, Baldwin clearly teaches against storing only a single copy of the Email communication on the server, and, in fact, stresses the importance of storing multiple copies of the Email communication on the server that each recipient can access.

40. As to part 1, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, Baldwin was not relied on to teach storing a single copy. Aronson is more specifically used for this limitation. Also, if the Applicant were to draw their attention to the prior art of Baldwin, column 3, lines 31 – 41, one would see that if the recipients do not have locations dedicated to storage of their messages, the message is deposited in message stores in the WAN **selected by the sender** and accessible to all of the intended recipients through **multiplexed access** to the message stores, **effectively consolidating the storage required**. This could mean that the sender could select the recipients to access the same storage for one message. Therefore, the prior art teaches the claim language.

41. In the Remarks, Applicant argues in substance that Baldwin does not teach if it is determined that multiple recipients have not been indicated, sending the Email communication to the recipient without waiting for a request for the Email communication.

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42. As to part 2, Examiner would like to draw the Applicant's attention to the newly added limitation to the independent claims. It is noted that Aronson is utilized to teach this limitation. Furthermore, the Applicant's specification is void of how this is done in their invention. Therefore, it is understood that it would be well known in the art if there is not written description in the specification as to how if there is only one recipient in an Email communication, it is directly sent to the recipient without requesting it. Also, this would cause problems in the system because if the user is not logged on the internet or an intranet then when the Email is directly sent to the user they would not be available, Unless this is not the case and the Email communication is actually sent to a server that the user has access to. Applicant is asked to explain or amend the claim language.

### *Conclusion*

43. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912.


The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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